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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,412	02/20/2004	Sven Bulow	KLAUS2.004AUS	6340
20995	7590	09/20/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			JOHNSON, JERROLD D	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3728	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,412

Applicant(s)

BULOW, SVEN

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Pay US 5,710,043.

Re claim 1, Pay discloses a modular array arrangement in Figs. 1 and 2 comprising:  
a carrier 12; and

at least one insert 24 for attachment to said carrier, said at least one insert having a first connecting means (male threads) arranged on or formed in at least one of the external walls of said at least one insert, said carrier having at least one location for receiving one of said at least one insert and comprising a second connecting means (female threads), said second connecting means being arranged in, adjacent to, or formed by said at least one location, said first connecting means unambiguously matching with said second connecting means, said unambiguously matching permitting to align said at least one insert in a predetermined orientation in or on said carrier, and said insert having at least one section defined for receiving a sample, said at least one section being provided with or adapted for receiving operational means.

With respect to the new recitations:

1) "so as to inhibit relative movement of the at least one insert with respect to the carrier", and

2) "wherein said first connecting means or said second connecting means is adapted to serve as a grip that extends outward from the insert a distance sufficient to permit transfer of the insert by a user or an automated machine while reducing the potential of contact by the user or the automated machine of the contents of the insert."

both of these limitations are met by the Pay reference.

Pay discloses an orientation where the insert is inhibited in movement relative to the carrier in several planes of movement while the insert is engaged to the carrier.

The threads of Pay are adapted to serve as a grip that extends outward from the insert a distance sufficient to permit transfer of the insert by a user or an automated machine while reducing the potential of contact by the user or the automated machine of the contents of the insert. Clearly the threads extend outwardly from the insert, like a knurl, provide a gripping surface for a users hand.

Re claim 2, said first connecting means is essentially or partially complementary to said second connecting means.

Re claim 3, said first connecting means or said second connecting means have an asymmetric structure or form. Although the individual thread shape is a "V" and is generally symmetrical in form, the plurality of threads disclosed are not symmetrical.

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Threads are disposed in a helical arrangement where there is a starting thread not of full height, and an ending thread not of full height. The plurality of threads of Pay are not symmetrical *about any axis or plane*.

Re claim 4, said first connecting means or said second connecting means is adapted to serve as a grip. External threads form a gripping surface.

Re claim 5, said insert is releasably or non-releasably connected to said carrier upon attachment to said carrier.

Re claim 6, wherein an insert is provided with one or more additional first connecting means or an insert receiving location is provided with one or more additional second connecting means.

Re claim 7, said operational means being selected from the group consisting of compounds attached to the insert surface, media, reagents, solvents, catalysts, coatings, and beads.

Re claims 8-14, note the rejection of claims 1-7. Additionally, the connecting means of Pay is a projection element (the male threads).

With specific respect to the new claim limitation in claim 8: "such that said at least one insert is held in a fixed orientation with respect to the carrier when the first and

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second connecting means are engaged with each other", fixed is understood from the present application to allow movement of the insert with respect to the carrier when the first and second connecting means are engaged with each other. Specifically, the insert is able to be moved in a vertical plane with respect to the carrier allowing removal of the insert from the carrier. Additionally, Webster's Collegiate Dictionary, tenth edition, defines fixed as "securely placed or fastened". Accordingly, the fixation of the insert in claim 8 is understood as securely placed within the carrier while still allowing movement at least in one plane.

Clearly Pay, which limits movements in most planes, is fixed to the extent that the insert of the present application is fixed. And, accordingly, Pay anticipates the claim.

Re claims 15-16, the methods are inherently disclosed by Pay. Note the rejection of claims 1-14.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ



Mickey Yu  
Supervisory Patent Examiner  
Group 3700